

REMARKS

I. PRELIMINARY REMARKS

No claims have been added or amended. Claims 42-47 have been canceled. Claims 1, 3, 5-15, 17, 19-32 and 35-41 remain in the application. Reexamination and reconsideration of the application, as amended, are respectfully requested.

Applicant notes with appreciation that claims 1, 3, 5-15, 17, 19-32 and 35-37 have been allowed.

II. REJECTIONS UNDER 35 U.S.C. § 103

A. The Rejections

Claims 38, 40-42 and 44-47 have been rejected under 35 U.S.C. § 103 as being unpatentable over the combined teachings of the Takezawa, Takemura and Honma patents. Claims 39 and 43 have been rejected under 35 U.S.C. § 103 as being unpatentable over the combined teachings of the Takezawa, Takemura, Honma and Noguchi patents. As claims 42-47 have been canceled, it is respectfully submitted that the rejections under 35 U.S.C. § 103 have been rendered moot. The rejections of claims 38-41 under 35 U.S.C. § 103 are respectfully traversed. Reconsideration thereof is respectfully requested.

B. The Cited References

The Takezawa patent discloses a variety of hybrid prepreg sheets. The hybrid prepreg sheet illustrated in Figure 3 is formed from two carbon fiber reinforced sheets 4A and 4B, which include reinforcing fibers 2, and a plurality of unidirectional foreign fibers 6 that are positioned between the fiber reinforced sheets. The foreign fibers 6 may be metal fibers. The Takezawa patent also discloses golf club shafts incorporating the hybrid

prepreg sheets. Referring to Figure 20 and column 22, lines 12-47, for example, the shafts include a plurality of conventional carbon fiber reinforced prepreg sheets in conjunction with one of the hybrid prepreg sheets. The Takezawa patent also states that the carbon fibers 2 in the sheets 4A and 4B are "**unidirectional**" (column 5, lines 52-62) and that the carbon fibers may be replaced by glass fibers (column 6, lines 24-34).

The Takemura patent discloses shafts including a number of conventional fiber reinforced resin layers. The fibers within each Takemura layer are unidirectional.

The Honma patent discloses a shaft with metal fibers 15 that are placed over a sheet of resin impregnated glass cloth 13. The Honma patent also specifically states that the **metal fibers are covered by a carbon fiber sheet**. [Column 3, lines 33-35.]

The Noguchi patent discloses a shaft with a transparent outer layer.

C. Discussion

Independent claim 38 calls for a combination of elements including, *inter alia*, an inner scrim cloth over fiber reinforced resin layers, an outer scrim cloth and a plurality of longitudinally extending metal fibers located between the inner and outer scrim cloths. The cited references fail to teach or suggest such a combination.

As noted in the Office Action at page 4, the Takezawa patent fails to teach or suggest the use of scrim cloth, let alone inner and outer scrim cloths with metal fibers therebetween, as called for in independent claim 38. The Office Action appears to have taken the position that because the Honma patent discloses the use of a **single** resin impregnated glass cloth over which metal fibers are placed, it would have been obvious to replace **both** of the Takezawa carbon fiber reinforced sheets with "scrim cloth." Even assuming only for the purposes of this response that the Honma resin impregnated glass cloth is "scrim cloth," and that there was some reason to combine the teachings of the references in the manner proposed in the Office Action, the resulting combination of teachings would not have produced a shaft with inner and outer scrim cloths and metal fibers therebetween. There simply is no outer scrim cloth disclosed in either patent and

no!
O

the Examiner has completely disregarded what the Honma patent actually teaches, i.e. that the Honma metal fibers are covered by a carbon fiber sheet.

Given the shortcomings in the cited references, the Examiner has based the rejection on the conclusory statement that it would have been obvious to replace the Takezawa inner and outer carbon fiber reinforced sheets with inner and outer scrim cloths "in order to utilize a fiberglass prepreg known in the art." [Office Action at page 3.] Applicant respectfully submits that this statement is incorrect as a matter of law and clearly indicates that the proper standard for determining patentability has not been applied. The Federal Circuit has indicated on many occasions that "it is insufficient to prove that at the time of the claimed invention, the separate elements of the device were present in the known art." See, e.g., *Winner International Royalty Corp. v. Wang*, 48 USPQ2d 1139, 1144 (Fed. Cir. 1998). To the contrary, "there must have been some **explicit** teaching or suggestion in the art to motivate one of even ordinary skill to combine such elements so as to create the same invention." *Id.* [Emphasis added.] Here, there is nothing whatsoever in the cited references that even remotely suggests the use of, *inter alia*, inner scrim cloth, an **outer** scrim cloth, and metal fibers therebetween. disagree

The Takemura patent, which has been cited for its purported teachings concerning certain shaft sections, fails to remedy the above-identified deficiencies in the Takezawa and Honma patents.

As the cited references fail to teach or suggest the combination of elements recited in independent claim 38, whether viewed alone or in combination, applicant respectfully submits that the rejection of claims 38, 40 and 41 under 35 U.S.C. § 103 is improper and should be withdrawn.

Turning to claim 39, the Noguchi patent fails to remedy the deficiencies in the, Takezawa, Honma and Takemura patents with respect to independent claim 38. As such, claim 39 is patentable for at least the same reasons as claim 38 and the rejection of claim 39 under 35 U.S.C. § 103 should also be withdrawn.

III. CLOSING REMARKS

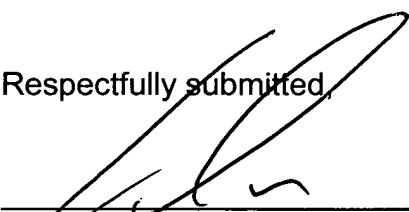
In view of the foregoing, it is respectfully submitted that the claims in the application are in condition for allowance. Reexamination and reconsideration of the application, as amended, are respectfully requested. Allowance of the claims at an early date is courteously solicited.

If for any reason the Examiner finds the application other than in condition for allowance, the Examiner is respectfully requested to call applicant's undersigned representative at (310) 563-1458 to discuss the steps necessary for placing the application in condition for allowance.

The Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment to Deposit Account No. 50-0638. Should such fees be associated with an extension of time, applicant respectfully requests that this paper be considered a petition therefor.

9/30/03
Date

Respectfully submitted,



Craig A. Slavin
Reg. No. 35,362
Attorney for Applicant

Henricks, Slavin & Holmes LLP
840 Apollo Street, Suite 200
El Segundo, CA 90245
(310) 563-1458
(310) 563-1460 (Facsimile)